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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/626,699	07/27/2000	William John Jones	A-68744/JGW	9907
25226 7590 04/09/2007 MORRISON & FOERSTER LLP 755 PAGE MILL RD PALO ALTO, CA 94304-1018			EXAMINER TODD, GREGORY G	
			ART UNIT 2157	PAPER NUMBER
SHORTENED STATUTORY PERIOD OF RESPONSE		MAIL DATE	DELIVERY MODE	
3 MONTHS		04/09/2007	PAPER	

**Please find below and/or attached an Office communication concerning this application or proceeding.**

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

**Office Action Summary**

Application No.

09/626,699

Applicant(s)

JONES ET AL.

Examiner

Gregory G. Todd

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 19 January 2007.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 46-53, 56-63, 66 and 67 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 46-53, 56-63, 66 and 67 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified-copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

## **DETAILED ACTION**

### ***Response to Amendment***

1. This office action is in response to applicant's amendment and request for continued examination filed 19 January 2007 of application filed, with the above serial number, on 27 July 2000 in which claims 46-48, 51, 56, and 66 have been amended and claims 54-55, 64-65 have been cancelled. Claims 46-53, 56-63, and 66-67 are therefore pending in the application.

### ***Claim Rejections - 35 USC § 103***

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claims 46, 48-50, 56, 58-60, and 66-67 are rejected under 35 U.S.C. 103(a) as being unpatentable over Fujiwara et al (hereinafter "Fujiwara", 6,064,879) in view of Lipsit (hereinafter "Lipsit", 5,956,636).

As per Claim 46, Fujiwara teaches a method for a server of a wireless network to register a user equipment:

receiving, via an anonymous communication session with the user equipment, a temporary ID and a temporary password identifying the user equipment as unregistered (temporary telephone number and ID) (at least col. 3 line 60 - col. 4 line 5; Fig. 3; col. 4, lines 15-35);

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obtaining authentication of the temporary ID and the temporary password (authenticating temporary information) (at least col. 1, lines 31-60; col. 3 line 60 - col. 4 line 5);

transmitting to the user equipment, via the anonymous communication session with the user equipment, a reply message comprising a request for registration information (at least col. 7 line 54 - col. 8 line 16; permanent).

Fujiwara fails to explicitly teach receiving, from the user equipment, in response to the request for registration information, a permanent ID and a permanent password. However, the use and advantages for using such a system is well known to one skilled in the art at the time the invention was made as evidenced by the teachings of Lipsit. Lipsit teaches a recipient using a wireless device being prompted and requested to input a security code as well as an ESN to be sent to the MSC for the wireless device to be activated/registered (at least col. 9, lines 13-54). Therefore, it would have been obvious to one of ordinary skill in the art, at the time the invention was made, to incorporate the use of Lipsit's system into Fujiwara as Lipsit's alternative activation/registration process allows the end recipient to activate the device using the ESN and security code of their choice.

As per Claim 47, Fujiwara fails to explicitly teach the requested registration information further comprises indicia of a preferred service provider, and the step of receiving includes receiving the indicia of a preferred service provider from the user equipment. However, the use and advantages for using such a service is well known to one skilled in the art at the time the invention was made as evidenced by the teachings

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of Lipsit (at least col. 6, lines 39-48). Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to incorporate the use of Lipsit's service provider choosing into Fujiwara's system as this would allow the user to use the pre-registered mobile unit with any service provider upon initial connection and not be limited to any one specific service provider as Lipsit teaches the customer calling the provider of their choice.

As per Claim 48, the method of claim 46 in which the requested registration information further comprises indicia of a requested type of service (user entering information) (at least col. 7, lines 3-53).

As per Claim 49, the method of claim 46 in which the requested registration information further comprises a preferred user name (user entering information) (at least col. 7, lines 3-53).

As per Claim 50, the method of claim 46 in which the reply message further comprises at least one protocol filter to restrict an access to the wireless network by the user equipment (at least col. 4, lines 15-34; restricting access).

As per Claim 56, Fujiwara teaches a method for a user equipment to register with a server of a wireless network, comprising:

transmitting, via an anonymous communication session with the server, a temporary ID and a temporary password identifying the user equipment as unregistered (temporary telephone number and ID) (at least col. 3 line 60 - col. 4 line 5; Fig. 3; col. 4, lines 15-35);

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receiving, via the anonymous communication with the server, a reply message comprising a request for registration information, the registration information comprising a permanent ID and a permanent password (at least col. 7 line 54 - col. 8 line 16; permanent); and

transmitting the requested registration via the anonymous communication session with the server (at least col. 7 line 54 - col. 8 line 16; Fig. 15).

Claims 57-60, and 66-67 do not substantially add or define any additional limitations over claims 46-50, and 56 and therefore are rejected for similar reasons.

4. Claims 51-53 and 61-63 are rejected under 35 U.S.C. 103(a) as being unpatentable over Fujiwara et al (hereinafter "Fujiwara", 6,064,879) in view of Lipsit (hereinafter "Lipsit", 5,956,636), and further in view of Rai (hereinafter "Rai", 6,675,208).

Fujiwara and Lipsit fail to teach the reply message further comprising passing, from the registration server arrangement to the computer, a designation for an Internet service provider that the user equipment may access via the wireless network, registration web page information, and registration software program for execution by the user equipment. However, the use and advantages for using such registration information is well known to one skilled in the art at the time the invention was made as evidenced by the teachings of Rai. Rai teaches wireless service providers providing internet access to end users (at least col. 5, lines 46-55; col. 8, lines 10-30; col. 43, lines 5-67). Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to incorporate the use of Rai's registration methods into

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Fujiwara and Lipsit's system as this would further enhance Fujiwara and Lipsit's system by allowing the registration process to occur using the internet as selected by the user in Rai, to offer more functionality and ease of use in setting up such registration of the computer and as these are well known variations in the art for registering subscribers.

### ***Response to Arguments***

5. Applicant's arguments with respect to claims 46-53, 56-63, and 66-67 have been considered but are moot in view of the new ground(s) of rejection.

### ***Conclusion***

6. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Newly cited Holmes and Mosher et al, in addition to previously cited Hawkins, Grube et al, Dailey, Vilander et al, Larkins, Tiedemann, Freitag et al, Chatterjee et al, Jones et al, and Ronneke are cited for disclosing pertinent information related to the claimed invention. Applicants are requested to consider the prior art reference for relevant teachings when responding to this office action.

7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Gregory G. Todd whose telephone number is (571)272-4011. The examiner can normally be reached on Monday - Friday 9:00am-6:00pm w/ first Fridays off.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ario Etienne can be reached on (571)272-4001. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Gregory Todd



Patent Examiner

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